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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,926	12/26/2001	Josh Malik	021902-093US	2195

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LOCKE LIDDELL & SAPP LLP  
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600 TRAVIS #3400  
HOUSTON, TX 77002

EXAMINER
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RETTA, YEHDEGA

ART UNIT	PAPER NUMBER
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3622

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/07/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/035,926

Applicant(s)

MALIK ET AL.

Examiner

Yehdega Retta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 19-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-4, drawn to first and second moveable members for recommending product, classified in class 705, subclass 14.
- II. Claims 5-8, drawn to first, second and third moveable members for recommending product, classified in class 705, subclass 14.
- III. Claims 9-16, drawn to first, second, third and fourth moveable members for recommending product, classified in class 705, subclass 14.
- IV. Claims 17-18, drawn to mechanical interface for mechanically selecting responses, classified in class 116, subclass 223.
- V. Claims 19-26, drawn to puzzle, classified in class 273, subclass 153.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because a base identifying a third question and a third moveable member is the particular feature of the subcombination which is not a limitation for the independently claimed combination I. The subcombination has separate utility such as indicating a recommended product when the first response portion is aligned with a first marker, ... and a third response portion is aligned with the third marker. Because the combination, as independently claimed

does not require the particulars of the subcombination of the Group II, this group shows a distinct relationship with each combination and subcombination. Examiner considers that since applicant independently claim the invention of this group, it is prima facie showing that the inventions are intended to be independent and distinct and are shown to be separately usable.

Inventions I and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because a base identifying a third question and a fourth question and a third moveable member and a fourth moveable member is the particular feature of the subcombination which is not a limitation for the independently claimed combination I. The subcombination has separate utility such as indicating a recommended product when the first response portion is aligned with a first marker, ... and a third response portion is aligned with the third marker and a fourth response portion is aligned with the fourth marker. Because the combination, as independently claimed does not require the particulars of the subcombination of the Group II, this group shows a distinct relationship with each combination and subcombination. Examiner considers that since applicant independently claim the invention of this group, it is prima facie showing that the inventions are intended to be independent and distinct and are shown to be separately usable.

Inventions II and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the

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subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because a base identifying a fourth question and a fourth moveable member is the particular feature of the subcombination which is not a limitation for the independently claimed combination II. The subcombination has separate utility such as indicating a recommended product when the first response portion is aligned with a first marker, ... and a fourth response portion is aligned with the fourth marker. Because the combination, as independently claimed does not require the particulars of the subcombination of the Group III, this group shows a distinct relationship with each combination and subcombination. Examiner considers that since applicant independently claim the invention of this group, it is prima facie showing that the inventions are intended to be independent and distinct and are shown to be separately usable.

Inventions IV and I-III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination IV has separate utility such as mechanical interface for mechanically selecting one of a plurality of responses and indicating product selected by dimensional sum of the responses. See MPEP § 806.05(d).

Inventions V and I-IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination V has separate utility such as a base and a sequence of a plurality of movable members capable of moving relative to the base. See MPEP § 806.05(d).

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Applicant's election without traverse of Group V, claims 19-26 in the reply filed on December 3, 2006 is acknowledged.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 19-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Danino et al. US 4,651,992.

Regarding claims 19, 22-26, Danino teaches a base and a sequence of a plurality of moveable members capable of moving relative to the base, each moveable member containing a marker capable of pointing to an associated response portion; wherein the last movable member indicates a response (see fig. 1-8). Danino teaches that the indicia could include a different number of indicia-carrying regions or faces. Danino also teaches other forms of indicia, such as alphabetical characters rather than numbers or arithmetic operations (see col. 3 lines 27 to col. 4 line 60). The data or indicia on the device are non-functional descriptive material, which does not have any patentable weight.

Regarding claims 20 and 21, Danino does not teach the base being a planner. However official notice is taken that is old and well known to use planner or cylindrical base to make the puzzle. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to use a base planner and to make the moveable members capable of moving in a horizontally in the planar base, as a design choice.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Danino et al. US 4,651,992 in view of Rofrano (US 6035283).

Regarding claims 19, 21-26, Danino teaches a base and a sequence of a plurality of moveable members capable of moving relative to the base, each moveable member containing a marker capable of pointing to an associated response portion; wherein the last movable member indicates a response (see fig. 1-8). Danino teaches that the indicia could include a different number of indicia-carrying regions or faces. Danino also teaches other forms of indicia, such as alphabetical characters rather than numbers or arithmetic operations (see col. 3 lines 27 to col. 4 line 60). Rofrano teaches providing question to customers and in response to the answers received recommending a product (see col. 4 line 1 to col. 5 line 45). It would have been obvious to one of the ordinary skill in the art at the time of the invention to use Danino's puzzle-type game to provide the recommendation of Rofrano by implement the question and answers into a game for those customers who do not use computer.

Regarding claims 20 and 21, Danino does not teach the base being a planner. However official notice is taken that is old and well known to use planner or cylindrical base to make the puzzle. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of

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the invention to use a base planner and to make the moveable members capable of moving in a horizontally in the planar base, as a design choice.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Johnson (US 4,949,969) teaches cylindrical puzzle with plurality of slide elements having faces displaying indicia.

Wood (D427,637) teaches a cylindrical device with numeral and other indicia.

Koll (US 4,329,570) teaches a planar base with moveable members moving longitudinally or horizontal direction.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

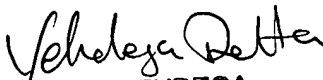
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

  
RETTA YEHDEGA  
PRIMARY EXAMINER